



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/551,656

09/30/2005

Akihiko Suzuki

MAT-8758US

4588

52473

7590

05/26/2009

RATNERPRESTIA

P.O. BOX 980

VALLEY FORGE, PA 19482

EXAMINER

SMITH, BENJAMIN J

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

05/26/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/551,656	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> Benjamin J. Smith	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/30/2005, 6/11/2008, 12/8/2008</u> .                         | 6) <input type="checkbox"/> Other: _____                          |



### **DETAILED ACTION**

This non-final office action is in response to the Application filed on 9/30/2005, with a priority date of 4/3/2003 in Japan.

Claims 1-11 are presented for examination. Claims 1, 6 and 7 are independent claims.

#### ***Claim Objections***

Claims 5, 10 and 11 recite the limitation "the time difference" in line 3. There is insufficient antecedent basis for this limitation in the claim.

This lack of antecedent basis also renders Claims 5, 10 and 11 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the applicant fails to claim what other factor is used in determining "the time difference".

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Art Unit: 2176

*Claim 7:*

In summary, Claim 7 recites a “*program*” that comprises a “*step of determining*” and a “*step of displaying*.” For purposes of examination, the examiner interprets the recited “*program*” as a computer software program that includes computer software modules for performing the recited “*determining*” and “*displaying*” steps. Thus, the recited “*program*” is software per se.

Accordingly, the “*program*” is not a “process,” a “machine,” a “manufacture” or a “composition of matter,” and Claim 7 fails to recite statutory subject matter, as defined in 35 U.S.C. 101.

Examiners Interpretation of Claim 1:

For purposes of 35 USC 101, the examiner has regarded the “moving picture storage unit” and the “moving picture display unit” as necessarily including hardware. That is, the “moving picture storage unit” and the “moving picture display unit” are interpreted as being hardware only or having hardware parts and not merely being software only.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*Claim 6:*

Claim 6 recites in its entirety, "*A moving picture **display device** for determining the output position of moving picture on the basis of position information related to moving picture, and displaying one or more moving pictures on the basis of the determination*" (emphasis added).

The claim is indefinite because it defines the invention as a "*display device*" without reciting a single component of the "*display device*." Rather, the claim merely recites two functions of the "*display device*:" 1) determining an "*output position*;" and 2) displaying "*moving pictures*." Because the claim fails to recite any components of the "*display device*," the intended scope of Claim 6 cannot be accurately determined.

Applicant must amend the claim to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, as required in 35 U.S.C. 112, second paragraph.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3 and 6-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Wakimoto et. al. US Patent Publication No. 2003/0095789, (hereinafter, "Wakimoto")

**Claim 1:**

Wakimoto discloses: *A moving picture display device [abstract] comprising:*  
*a moving picture storage unit for storing one or more moving pictures [paragraph 0153 and fig. 1] having position information as attribute values [paragraph 0305 and fig. 19] ["scene of bldg. a" is position information as well as the latitude and longitude]; and*  
*a moving picture display unit for displaying the one or more moving pictures [paragraph 0014 and fig. 39] [the video play back window],*  
*wherein the moving picture display unit displays the position information corresponding to the moving picture visually when displaying the moving picture [paragraph 0014 and fig. 39 or paragraph 0305 and fig. 19] [in fig. 39 the position information displayed is the description of the frame or moving picture, e.g. "airport" or "railroad"; in fig. 19 the latitude, longitude and description are displayed along with the moving picture] [Examiners Interpretation: the Claim is not clear as to how the "moving*

Art Unit: 2176

picture" is displayed, it has been interpreted as only displaying an image of the "moving picture" but not actually playing the "moving picture"].

**Claim 2:**

Wakimoto discloses: *The moving picture display device of claim 1, further comprising:*

*a map information storage unit for storing map information [paragraph 0303]  
[moving picture data stored]; and*

*a map display unit for displaying the map information [paragraph 0293 and fig. 17] [displayed in the map window],*

*wherein the moving picture display unit disposes and displays the moving picture on the map information shown by the map display unit on the basis of the map information corresponding to the moving picture [paragraph 0315] [map indicator may be symbols or sound or graphics].*

**Claim 3:**

Wakimoto discloses: *The moving picture display device of claim 1, wherein the moving picture display unit displays two or more moving pictures, and also display the position relation of two or more moving pictures visually, on the basis of two or more pieces of position information as attribute values of two or more moving pictures being displayed [paragraph 0305 and fig. 19] [an index list of moving pictures is displayed along with position information and they can be selected for playback] [Examiners*



Art Unit: 2176

Interpretation: the Claim is not clear as to how the "moving picture" is displayed, it has been interpreted as only displaying an image of the "moving picture" but not actually playing the "moving picture"].

**Claim 6:**

Wakimoto discloses: *A moving picture display device for determining the output position of moving picture on the basis of position information related to moving picture values* [paragraph 0305 and fig. 19] ["scene of bldg. a" is position information as well as the latitude and longitude], *and displaying one or more moving pictures on the basis of the determination* [paragraph 0293 and fig. 17] [displayed in the map window] [paragraph 0305 and fig. 19] [an index list of moving pictures is displayed along with position information and they can be selected for playback],

**Claim 7:**

Wakimoto discloses: *A program causing a computer to execute, comprises:*  
*a step of determining the display position of moving picture on the basis of position information pairing with one or more moving picture values* [paragraph 0305 and fig. 19] ["scene of bldg. a" is position information as well as the latitude and longitude]; *and*

*a step of displaying one or more moving pictures at the position shown by the display position* [paragraph 0293 and fig. 17] [displayed in the map window] [paragraph

Art Unit: 2176

0305 and fig. 19] [an index list of moving pictures is displayed along with position information and they can be selected for playback.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5 and 8-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Wakimoto as applied to claims 1-3 above, and further in view of Prijatel et. al US Patent Publication No. 2002/0199189 (hereinafter, "Prijatel").

**Claim 4:**

Wakimoto teaches all the claimed elements of claims 1-3 as disclosed above

Wakimoto fails to teach:

*The moving picture display device of claim 1, further comprising: a present time acquiring unit for acquiring the present time, wherein the moving picture display unit displays part of the moving picture corresponding to the present time when displaying the moving picture.*

Prijatel teaches:

Art Unit: 2176

*The moving picture display device of claim 1, further comprising: a present time acquiring unit for acquiring the present time [paragraph 0015] [determining a current time], wherein the moving picture display unit displays part of the moving picture corresponding to the present time when displaying the moving picture [paragraph 0016] [combining promotional video content to a video based on the current time].*

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of moving picture playback in Wakimoto with the method of incorporating additional moving pictures in Prijatel.

This combination would have been useful for inserting or adding moving pictures for personalizing the content in the moving pictures.

**Claim 5:**

Wakimoto discloses *The moving picture display device of claim 4, wherein the moving picture display unit displays part of the moving picture corresponding to the present time considering the time difference [paragraphs 0042-0043] [determines time difference and incorporates video based on the difference].*

**Claim 8:**

Wakimoto teaches all the claimed elements of claims 1-3 as disclosed above

Wakimoto fails to teach:

Art Unit: 2176

*The moving picture display device of claim 2, further comprising:  
a present time acquiring unit for acquiring the present time,  
wherein the moving picture display unit displays part of the moving picture  
corresponding to the present time when displaying the moving picture.*

Prijatel teaches:

*The moving picture display device of claim 2, further comprising:  
a present time acquiring unit for acquiring the present time [paragraph 0015]  
[determining a current time],  
wherein the moving picture display unit displays part of the moving picture  
corresponding to the present time when displaying the moving picture [paragraph 0016]  
[combining promotional video content to a video based on the current time].*

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of moving picture playback in Wakimoto with the method of incorporating additional moving pictures in Prijatel.

This combination would have been useful for inserting or adding moving pictures for personalizing the content in the moving pictures.

**Claim 9:**

Wakimoto teaches all the claimed elements of claims 1-3 as disclosed above

Art Unit: 2176

Wakimoto fails to teach:

*The moving picture display device of claim 3, further comprising:*

*a present time acquiring unit for acquiring the present time,*

*wherein the moving picture display unit displays part of the moving picture corresponding to the present time when displaying the moving picture.*

Prijatel teaches:

*The moving picture display device of claim 3, further comprising:*

*a present time acquiring unit for acquiring the present time [paragraph 0015]*

*[determining a current time],*

*wherein the moving picture display unit displays part of the moving picture*

*corresponding to the present time when displaying the moving picture [paragraph 0016]*

*[combining promotional video content to a video based on the current time].*

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of moving picture playback in Wakimoto with the method of incorporating additional moving pictures in Prijatel.

This combination would have been useful for inserting or adding moving pictures for personalizing the content in the moving pictures.

Art Unit: 2176

**Claim 10:**

Wakimoto discloses *The moving picture display device of claim 8, wherein the moving picture display unit displays part of the moving picture corresponding to the present time considering the time difference* [paragraphs 0042-0043] [determines time difference and incorporates video based on the difference].

**Claim 11:**

Wakimoto discloses *The moving picture display device of claim 9, wherein the moving picture display unit displays part of the moving picture corresponding to the present time considering the time difference* [paragraphs 0042-0043] [determines time difference and incorporates video based on the difference].

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin J. Smith whose telephone number is (571) 270-3825. The examiner can normally be reached on Monday through Friday 8:30AM-5:00PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin J. Smith/  
Examiner, Art Unit 2176

/DOUG HUTTON/  
Supervisory Patent Examiner, Art Unit 2176